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10/675,081	09/30/2003	Jeyhan Karaoguz	14306US02	5083

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EXAMINER

MENDOZA JR, JORGE

ART UNIT	PAPER NUMBER
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4126

MAIL DATE	DELIVERY MODE
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10/26/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/675,081

Applicant(s)

KARAOGUZ ET AL.

Examiner

Jorge Mendoza

Art Unit

4126

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09/30/2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09/30/2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

1. **Claims 1-31** are presented for Examination.

Priority

2. A reference to the prior application No. 60/432472, filed on December 11, 2002, application No. 60/443,894, filed January 30, 2003, application No. 60/457,179, filed March 25, 2003, and application No. 60/445,936, filed on February 7, 2003 have been inserted as the first sentence(s) of the specification of this application or in an application data sheet (37 CFR 1.76). The claim for benefit of relying on the filing date of the prior application under 35 U.S.C. 119(e), 120, 121, or 365(c) is acknowledged.

Information Disclosure Statement

3. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered. Incorporated references (Attorney Docket No. 14185US02, Attorney Docket No. 14274US02, and Attorney Docket No. 114307US02) are disclosed in paragraph [02] and incorporated reference (Attorney Docket No. 14305US02) is disclosed in paragraph [45] of the specification.

Specification

4. The disclosure is objected to because of the following informalities: Information provided in paragraphs [02] and [45] is incomplete. US Patent Application numbers are missing in the Incorporated by Reference section and in the specification. Appropriate correction is required.

5. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The specification does not distinctly define the characteristics of each of the claimed processors of claim 31: a media processing system processor, a media management system processor, a computer processor, media exchange software processor, and a media peripheral processor (paragraph [86]). Without further disclosure as to the distinctness of each claimed processor in claim 31, each claimed processor will be treated as indistinguishable and therefore the broadest reasonable interpretation of a processor will be used in the interpretation of claim 31.

Drawings

6. The drawings are objected to because figure letter 'C' of Figure 5 is labeling an incorrect location as mention in the specification. According to paragraph [64] of the specification, step 'C' should be labeling where 'the first party 501 accesses the third-party channel 504 using a media guide user interface 502 on a PC 503'. Corrected

Art Unit: 4126

drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct

Art Unit: 4126

from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. **Claims 1-31** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims **1-31** of co-pending Application No. 10/675,489 in view of **Walker et al. (PG Pub 2001/0018771)**.

With respect to **Claim 1**, the claimed "delivering the broadcast television program for display on a television screen within a home" is met by claim 1 of the co-pending application that teaches the delivery of a broadcast television program for display on a

Art Unit: 4126

television screen within a home. The claimed "receiving an input from a user that selects a function which corresponds to at least a portion of the broadcast television program during said delivering" is met by claim 1 of the co-pending application that teaches receiving an input from a user that selects a function which corresponds to an announcement, said announcement being part of the broadcast television program. The claimed "in response to said received input, performing said function at least in part outside said home" is met by claim 2 of the co-pending application that teaches the performing of a function, as a response to an input, at least in part outside of a home.

With respect to **Claim 2**, the claimed "associating said function with the broadcast television program" is not explicitly taught by the co-pending application. However, the Walker et al. reference teaches the use of program identification information **33** in distinguishing the video program being currently viewed from those that are also being broadcasted (paragraph 0044).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate the teachings of Walker et al. with those of the co-pending application in order to provide a manner in which to distinguish the broadcast television program having the selected function. A person with ordinary skill in the art would have been motivated to make the modification to the co-pending application in order to provide an accurate communication of the selected function.

With respect to **Claim 3**, the claimed "notifying said user of said function corresponding to said at least a portion of the broadcast television program" is met by Walker et al. that teach the use of a event database **56a**, within a display device **50**, to

Art Unit: 4126

display to a viewer the supplemental information available for the program being viewed (paragraph [0062] and Fig. 5).

With respect to **Claim 4**, the claimed "broadcasting an indication of said function along with the broadcast television program" is met by Walker et al. that teach the notification of available supplemental information by way of pop windows, menu choices, dialog boxes, etc. on a display **63** (Fig.3 and paragraph [0072]).

Claim 5 is met by claim 6 of the co-pending application.

Claim 6 is met by claim 7 of the co-pending application.

Claim 7 is met by claim 8 of the co-pending application.

Claim 8 is met by claim 9 of the co-pending application.

Claim 9 is met by claim 10 of the co-pending application.

Claim 10 is met by claim 3 of the co-pending application.

Claims 11-31 contain the same limitations as discussed in claims 1-10 above.

Therefore, they are rejected under the same rationale.

This is a provisional obviousness-type double patenting rejection.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. **Claims 1-31** are rejected under 35 U.S.C. 102(b) as being anticipated by **Walker et al. (US Patent Application Publication 2001/0018771)**.

Art Unit: 4126

With respect to **Claim 1**, the claimed “delivering the broadcast television program for display on a television screen within a home” is met by Walker et al. that teach a system in which broadcast television programs are delivered to a television receiver **30** which displays the received content to a viewer **80** (Fig.1 and paragraph [0042]). The claimed “receiving an input from a user that selects a function which corresponds to at least a portion of the broadcast television program during said delivery; and in response to said received input, performs said function at least in part outside said home” is met by Walker et al. that teach a system in which a viewer **80** provides specific data (program identification information **33** & synchronization information **32**) to a web site server **70**, the server uses this data to access the pertinent supplemental data and thereby sends it to the requesting viewer (Fig.1&3; paragraphs [0018], [0051], [0055] & [0061]).

With respect to **Claim 2**, the claimed “associating said function with the broadcast television program” is met by Walker et al. that teach the use of program identification information **33** in distinguishing the video program being currently viewed from those that are also being broadcasted (paragraph 0044).

With respect to **Claim 3**, the claimed “notifying said user of said function corresponding to said at least a portion of the broadcast television program” is met by Walker et al. that teach the use of a event database **56a**, within a display device **50**, to display to a viewer the supplemental information available for the program being viewed (paragraph [0062] and Fig. 5).

With respect to **Claim 4**, the claimed "broadcasting an indication of said function along with the broadcast television program" is met by Walker et al. that teach the notification of available supplemental information by way of pop windows, menu choices, dialog boxes, etc. on a display **63** (Fig.3 and paragraph [0072]).

With respect to **Claim 5**, the claimed "wherein said input is a code representative of said function" is met by Walker et al. that teach the use of specific numbers (program ID info **33** & synchronization info **32**) in obtaining supplemental information associated with a particular scene in a video program (Fig.2, paragraph [0045]).

With respect to **Claim 6**, the claimed "wherein said input is generated from at least one of a remote control, a keyboard, a scanning device and an audio processing device" is met by Walker et al. that teach the use of an input device **62** (such as a keyboard, mouse, joystick, trackballs, remote control, video cameras, or speech recognition devices) in inputting data for the retrieval of supplemental data (Fig.3 and paragraph [0061]).

With respect to **Claim 7**, the claimed "generating supplemental information related to the broadcast television program in response to said received input" is met by Walker et al. that teach the retrieval of supplemental information upon data being inputted by the viewer, the data then being processed by CPU **51** of the integrated display device **50** in order to access supplemental data via a web site server **70** (Fig.3 & 4; and paragraph [0069]).

With respect to **Claim 8**, the claimed "presenting said supplemental information to said user" is met by Walker et al. teaching the displaying of the supplemental

Art Unit: 4126

information on an integrated display device **50**, in such a manner in which it is synchronized with the corresponding video program (paragraph [0071]).

With respect to **Claim 9**, the claimed “presenting said supplemental information to said user concurrently with said delivery of the broadcast television program” is met by Walker et al. that teach the use of an integrated display device **50** in displaying a video program and the supplemental information associated with it (Fig.3 and paragraphs [0055] and [0062]).

With respect to **Claim 10**, the claimed “displaying information related to said performance of said function” is met by Walker et al. that teach the use of a database, simulcast event database **56a**, in keeping a record of the related supplemental information available for a particular video program (Fig.5 and paragraph [0062]).

Claim 11 is met as previously discussed with respect to claim 1.

Claim 12 is met as previously discussed with respect to claim 2.

Claim 13 is met as previously discussed with respect to claim 3.

Claim 14 is met as previously discussed with respect to claim 4.

Claim 15 is met as previously discussed with respect to claim 5.

Claim 16 is met as previously discussed with respect to claim 6.

Claim 17 is met as previously discussed with respect to claim 7.

Claim 18 is met as previously discussed with respect to claim 8.

Claim 19 is met as previously discussed with respect to claim 9.

Claim 20 is met as previously discussed with respect to claim 10.

Art Unit: 4126

Claim 21 is met as previously discussed with respect to claim 1. Furthermore, Walker et al. teach the use of a processor, CPU 51, in performing a number of functions. Among these functions, the CPU 51 takes part in delivering a broadcast television program for display on a TV, in receiving an input from a user correlating a function to a portion of the broadcast TV program, and in performing selected function outside of the home in response to the users input (Fig.3, paragraphs [0018], [0051], [0055], & [0061]).

Claim 22 is met as previously discussed with respect to claim 2.

Claim 23 is met as previously discussed with respect to claim 3.

Claim 24 is met as previously discussed with respect to claim 4.

Claim 25 is met as previously discussed with respect to claim 5.

Claim 26 is met as previously discussed with respect to claim 6.

Claim 27 is met as previously discussed with respect to claim 7.

Claim 28 is met as previously discussed with respect to claim 8.

Claim 29 is met as previously discussed with respect to claim 9.

Claim 30 is met as previously discussed with respect to claim 10.

With respect to **Claim 31**, the claimed "wherein said at least one processor is at least one of a media processing system processor, a media management system processor, a computer processor, media exchange software processor, and a media peripheral processor" is met by Walker et al. that teach the use of a processor, CPU 51, in the integrated display device 50 (Fig.3).

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Matthews III (US Pat 5,600,368) teaches a system in which a set top box interacts with an interactive television and a remote control in order to allow a user to view a video program from multiple camera angles.

Shoff et al. (US Pat 6,240,555) teach a system of supporting available interactive content video programs related to video programs being presented to viewers.

Fries (US 6,317,885) teaches the use of a television set top box in an interactive entertainment and information system.

McKenna (US Pat Application Publication 2003/0018971) teaches the use of program interface object in retrieving supplemental information pertaining to a television program.

Art Unit: 4126

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Jorge Mendoza Jr.** whose telephone number is (571) 270-5087. The examiner can normally be reached on Monday through Friday 7:30 am – 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Dennis Chow** can be reached at (571) 272-7767. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 8660217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jorge Mendoza Jr.
October 23, 2007

Lu-Yi Lin
Primary Examiner

L. Y. Lin